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ART UNIT	**PAPER NUMBER**
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/849,297	SAUNDERS, ROBERT MILES	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 04 May 2001. Claims 1-23 are pending.

Claim Rejections - 35 USC § 101

2. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena that do not apply, involve, use, or advance technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject

matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, exemplary claim 1 is drawn to a method for issuing insurance comprising the steps of "receiving...," and "issuing...". It is not clear whether or not the recited steps of receiving and issuing actively apply, involve, use, or advance the technological arts. In particular, these acts are capable of being performed in the human mind or via paper and pencil. As such, there is no specific requirement with the language of the claim to a practical application WITHIN the technological arts, as there is no requirement for any of the recited steps to be performed electronically or via computerized database components.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, exemplary claim 1 is drawn to a method for issuing insurance, and as such, appears to produce a useful, concrete, and tangible result, namely an a method of offering sundry insurance products.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Claims 2-21 fail to further recite a positive and definite limitation to the technological arts, and also fail to pass muster under 35 U.S.C 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Regarding claims 3, 5 and 13, the phrase "similar" renders the claim indefinite because it is unclear what Applicant intended to cover by the recitation "similar." See MPEP § 2173.05(b).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 10, 12, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti (Pitti, Donald R. "Variable Life: The Buyer's Choice" Feb. 1989. Best's Review. pg. 52-54.; hereinafter Pitti) in view of Rothman (Rothman, Sheri. "Replacing Insurance Gets Harder In New York" Jan. 1, 1999. Bank Investment Marketing. pg. 1; hereinafter Rothman) and further in view of Sobczak (Sobczak, Carol A., Robins, Lawrence A. "Irrevocable Life Insurance Trusts" Sep/Oct 1996. Vol. 28, Iss. 5. pg. 46; hereinafter Sobczak).

(A) As per claim 1, Pitti discloses a method for issuing an investment style life insurance policy to an insured comprising:

(a) issuing by the issuer an investment style life insurance policy to the insured (Pitti: pgs. 52-54) (Examiner also notes Applicant's admission (that this feature is old and well known in the art), in the background of the invention of the present application (09/849,297), that states the following:

> "Another general form of life insurance is a combination of investment and life insurance. 'Investment Style' Life Insurance comes in many forms, such as, *inter alia*, Universal Life, Whole Life, Flexible Life and Variable Life. We shall use the term 'Combination Investment/Life Insurance' to refer to it herein. Combination Investment/Life Insurance is considerably more complex than Term Life Insurance in that, integrated into the policy is an investment vehicle that has the potential of increasing in value..." (hereinafter Admission #1).

Pitti, however, fails to expressly disclose a method for issuing an investment style life insurance policy to an insured comprising:

(b) receiving by an issuer of the investment style life insurance policy ownership of an existing term life insurance policy on the insured having a defined death benefit; and

(c) a death benefit of the investment style life insurance policy equals the defined death benefit of the existing term life insurance policy received by the issuer.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses a method for issuing an investment style life insurance policy to an insured comprising:

(b) receiving by an issuer of the investment style life insurance policy ownership of an existing term life insurance policy on the insured having a defined death benefit (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for issuing an investment style life insurance policy to an insured comprising:

(c) a death benefit of the investment style life insurance policy equals the defined death benefit of the existing term life insurance policy received by the issuer (Rothman: pg. 1 of 2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the

motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(B) As per claim 10, Pitti discloses a method for converting an existing term life insurance policy having a defined death benefit into an investment style life insurance policy comprising:

(a) issuing an investment style life insurance policy to the insured (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for converting an existing term life insurance policy having a defined death benefit into an investment style life insurance policy comprising:

(b) obtaining by an issuer from an insured a designation of the issuer as a beneficiary of the existing term life insurance policy; and

(c) a death benefit equal to the defined death benefit of the existing term life insurance policy.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses a method for converting an existing term life insurance policy having a defined death benefit into an investment style life insurance policy comprising:

(b) obtaining by an issuer from an insured a designation of the issuer as a beneficiary of the existing term life insurance policy (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for converting an existing term life insurance policy having a defined death benefit into an investment style life insurance policy comprising:

(c) a death benefit equal to the defined death benefit of the existing term life insurance policy (Rothman: pgs. 1-2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the

benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(C) As per claim 12, Pitti discloses a method for issuing a combination investment/life insurance policy comprising:

(a) receiving a specification as to one or more assets, rights or liabilities in which an insured desires to invest (Pitti: pgs. 52-54);

(b) issuing a combination investment/life insurance policy (Pitti: pgs. 52-54) and having as an underlying investment vehicle the specified one or more assets, rights or liabilities (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for issuing a combination investment/life insurance policy comprising:

(c) receiving from an insured a designation as an owner of a term life insurance policy on the insured having a defined death benefit; and

(d) including a death benefit equal to the defined death benefit.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses a method for issuing a combination investment/life insurance policy comprising:

(c) receiving from an insured a designation as an owner of a term life insurance policy on the insured having a defined death benefit (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for issuing a combination investment/life insurance policy comprising:

(d) including a death benefit equal to the defined death benefit (Rothman: pgs. 1-2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(D) As per claim 17, Pitti discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(a) a combination investment/life insurance policy (Pitti: pgs. 52-54); and

(b) issuing a new combination investment/life insurance policy (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for modifying a combination investment/life insurance policy on an insured comprising:

(c) receiving ownership of the insurance policy;

(d) receiving ownership of a new term life insurance policy; and

(e) a death benefit equal to the defined death benefit of the new term life insurance policy.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(c) receiving ownership of the insurance policy (Sobczak: pgs. 1-2); and

(d) receiving ownership of a new term life insurance policy (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(e) a death benefit equal to the defined death benefit of the new term life insurance policy (Rothman: pgs. 1 of 2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

7. Claims 2,3,7,8,11,14,15,18, 20 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Rothman, in further view of Sobczak, and further in view of Golden (5,933,815; hereinafter Golden).

(A) As per claim 2, Pitti fails to expressly disclose the method according to claim 1, further comprising receiving by the issuer one or more assets, rights and/or liabilities from the insured.

Nevertheless, this feature is old and well known in the art, as evidenced by Golden. In particular, Golden discloses the method according to claim 1, further comprising receiving by the issuer one or more assets, rights and/or liabilities from the insured (Golden: col. 12, lines 47-51).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti, Rothman and Sobczak with the motivation providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

(B) As per claim 3, Pitti discloses the method according to claim 2, wherein an investment vehicle of the investment style life insurance policy includes either said one or more assets, rights and/or liabilities or one or more other assets, rights and/or liabilities similar to said one or more assets, rights and/or liabilities (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

(C) As per claim 7, Pitti fails to expressly disclose the method according to claim 6, wherein the insured designates the issuer as a beneficiary of the existing term life insurance policy on the insured.

Nevertheless, this feature is old and well known in the art, as evidenced by Sobczak. In particular, Sobczak discloses the method according to claim 6, wherein the insured designates the issuer as a beneficiary of the existing term life insurance policy on the insured (Sobczak: pgs. 1-2).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the combined teachings of Pitti, Rothman and Golden with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

(D) As per claim 8, Pitti fails to expressly disclose the method according to claim 7, wherein the investment style life insurance policy includes a death benefit for the insured equal to a death benefit of the existing term life insurance policy on the insured that was transferred to the issuer.

Nevertheless, this feature is old and well known in the art, as evidenced by Rothman. In particular, Rothman discloses the method according to claim 7, wherein the investment style life insurance policy includes a death benefit for the insured equal to a death benefit of the existing term life insurance policy on the insured that was transferred to the issuer (Rothman: pgs. 1-2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti,

Sobczak and Golden with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(E) As per claim 11, Pitti discloses the method according to claim 10, further comprising one or more assets, rights and/or liabilities representing an investment vehicle of the investment style life insurance (Pitti: pgs. 52-54).

Pitti, however, fails to expressly disclose the method according to claim 10, further comprising transferring one or more assets, rights and/or liabilities to the issuer.

Nevertheless, this feature is old and well known in the art, as evidenced by Golden. In particular, Golden discloses the method according to claim 10, further comprising transferring one or more assets, rights and/or liabilities to the issuer (Golden: col. 12, lines 47-51).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti, Rothman and Sobczak with the motivation providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

(F) As per claim 14, Pitti discloses the method according to claim 13, further comprising a combination investment life insurance policy (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose the method according to claim 13, further comprising receiving by the issuer a designation of the issuer as a beneficiary of an existing term life insurance policy on the insured, wherein the insurance policy includes a death benefit equal to a death benefit of the existing term life insurance policy.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses the method according to claim 13, further comprising receiving by the issuer a designation of the issuer as a beneficiary of an existing term life insurance policy on the insured (Sobczak: pgs. 1-2).

Rothman, on the other hand, discloses an insurance policy that includes a death benefit equal to a death benefit of the existing term life insurance policy (Rothman: pgs. 1-2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the combined teachings of Pitti and Golden with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti, Sobczak and Golden with the motivation of providing consumers with

additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(G) As per claim 15, Pitti discloses a method for converting an existing term life insurance policy having a defined death benefit for a particular insured into a combination investment/life insurance policy comprising:

(a) an issuer of a combination investment/life insurance policy (Pitti: pgs. 52-54);

(b) issuing a combination investment/life insurance policy (Pitti: pgs. 52-54);

(c) investment vehicle includes one or more assets, rights or liabilities (Pitti: pgs. 52-54) (Examiner also notes Admission #1); and

Pitti, however, fails to expressly disclose a method for converting an existing term life insurance policy having a defined death benefit for a particular insured into a combination investment/life insurance policy comprising:

(d) receiving a designation of a beneficiary of the existing term life insurance policy;

(e) receiving a specified investment vehicle from the insured;

(f) a death benefit equal to the defined death benefit of the existing term life insurance policy.

Nevertheless, these features are old and well known as evidenced by Sobczak, Rothman and Golden. In particular, Sobczak discloses a method for converting an existing term life insurance policy having a defined death benefit for a particular insured into a combination investment/life insurance policy comprising:

(d) receiving a designation of a beneficiary of the existing term life insurance policy (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for converting an existing term life insurance policy having a defined death benefit for a particular insured into a combination investment/life insurance policy comprising:

(f) a death benefit equal to the defined death benefit of the existing term life insurance policy (Rothman: pgs. 1-2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

Golden, on the other hand, discloses a method for converting an existing term life insurance policy having a defined death benefit for a particular insured into a combination investment/life insurance policy comprising:

(e) receiving a specified investment vehicle from the insured (Golden: col. 12, lines 47-51);

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti, Rothman and Sobczak with the motivation providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

(H) As per claim 18, Pitti discloses the method according to claim 17, wherein the new combination investment/life insurance policy includes an investment vehicle comprised of said one or more new assets, rights and/or liabilities (Pitti: pgs. 52-54).

Pitti, however, fails to expressly disclose the method according to claim 17, further comprising receiving ownership of one or more new assets, rights and/or liabilities.

Nevertheless, this feature is old and well known in the art, as evidenced by Golden. In particular, Golden discloses the method according to claim 17, further comprising receiving ownership of one or more new assets, rights and/or liabilities (Golden: col. 12, lines 47-51).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti, Rothman and Sobczak with the motivation providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

(I) As per claim 20, Pitti discloses the method according to claim 19, further comprising a new combination investment/life insurance policy (Pitti: pgs. 52-54).

Pitti, however, fails to expressly disclose the method according to claim 19, further comprising receiving ownership of a new term life insurance policy having a defined death benefit from the insured, wherein insurance policy includes a death benefit equal to the defined death benefit of the new term life insurance policy.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Rothman. In particular, Sobczak discloses the method according to claim 19, further comprising receiving ownership of a new term life insurance policy (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses the method according to claim 19, further comprising an insurance policy having a defined death benefit from the insured, wherein insurance policy includes a death benefit equal to the defined death benefit of the new term life insurance policy (Rothman: pgs. 1 of 2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti and Golden with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti, Sobczak and Golden with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

(J) As per claim 22, Pitti discloses a method for issuing an investment style life insurance policy to an insured over a computer network comprising:

(a) issuing by the issuer an investment style life insurance policy to the insured (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for modifying a combination investment/life insurance policy on an insured comprising:

(b) receiving via the computer network;
(c) receiving by an issuer of the investment style life insurance policy assignment of an existing term life insurance policy on the insured having a defined death benefit;
(d) a death benefit of the investment style life insurance policy equals the defined death benefit of the existing term life insurance policy received by the issuer; and
(e) receiving via the computer network by the issuer assignment to one or more assets, rights and/or liabilities from the insured.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak, Rothman and Golden. In particular, Sobczak discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(c) receiving by an issuer of the investment style life insurance policy assignment of an existing term life insurance policy on the insured having a defined death benefit (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Rothman, on the other hand, discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(d) a death benefit of the investment style life insurance policy equals the defined death benefit of the existing term life insurance policy received by the issuer (Rothman: pg. 1 of 2) (Examiner notes that under Rothman a replacement insurance policy can be devised in which the benefit is less than, equal to, or greater than the benefit of the existing policy to be replaced/terminated/modified.).

Golden, on the other hand, discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(b) receiving via the computer network (Golden: col. 2, lines 41-45; Fig. 1); and

(e) receiving via the computer network by the issuer assignment to one or more assets, rights and/or liabilities from the insured (Golden: col. 2, lines 41-45; col. 12, lines 47-51; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

Moreover, one of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti, Rothman and Sobczak with the motivation of providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Rothman in further view of Sobczak, and further in view of Smith (US 2002/0091610; hereinafter Smith).

(A) As per claim 4, Pitti fails to expressly disclose the method according to claim 1, further comprising receiving by the issuer periodic premium payments from the insured.

Nevertheless, this feature is old and well known in the art, as evidenced by Smith. In particular, Smith discloses the method according to claim 1, further comprising receiving by the issuer periodic premium payments from the insured (Smith: pg. 1, par. [0010]).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Smith with the combined teachings of Pitti, Rothman and Sobczak with the motivation of 1) providing a means of transferring assets (e.g., premiums) from a taxable classification, or status, to vehicles which can hold those assets in a non-taxable status and 2) reinvesting those assets into various investments (Smith: pg. 1, par. [0009] and [0010]).

9. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Golden.

(A) As per claim 5, Pitti discloses a method for issuing an investment style life insurance policy to an insured comprising:

(a) issuing by the issuer an investment style life insurance policy to the insured, in which an underlying investment vehicle includes either said one or more assets, rights and/or liabilities or one or more other assets, rights and/or liabilities similar to those received by the issuer from the insured (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for issuing an investment style life insurance policy to an insured comprising:

(a) receiving by an issuer of the investment style life insurance policy one or more assets, rights and/or liabilities held by the insured.

Nevertheless, these features are old and well known in the art, as evidenced by Golden. In particular, Golden discloses a method for issuing an investment style life insurance policy to an insured comprising:

(b) receiving by an issuer of the investment style life insurance policy one or more assets, rights and/or liabilities held by the insured (Golden: col. 12, lines 47-51); and

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the teachings of Pitti with the motivation of providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

(B) As per claim 13, Pitti discloses a method for converting ownership in existing assets, rights or liabilities into an investment in similar assets, rights or liabilities that grow tax free comprising:

(a) issuing a combination investment/life insurance policy in which an underlying investment vehicle includes the similar assets, rights or liabilities (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for converting ownership in existing assets, rights or liabilities into an investment in similar assets, rights or liabilities that grow tax free comprising:

(b) receiving an assignment of ownership in the existing assets, rights or liabilities by an issuer of a combination investment/life insurance policy.

Nevertheless, these features are old and well known in the art, as evidenced by Golden. In particular, Golden discloses a method for converting ownership in existing assets, rights or liabilities into an investment in similar assets, rights or liabilities that grow tax free comprising:

(b) receiving an assignment of ownership in the existing assets, rights or liabilities by an issuer of a combination investment/life insurance policy (Golden: col. 12, lines 47-51).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the teachings of Pitti with the motivation of providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Rothman, and further in view of Golden.

(A) As per claim 6, Pitti fails to expressly disclose the method according to claim 5, further comprising receiving by the issuer an existing term life insurance policy on the insured from the insured.

Nevertheless, this feature is old and well known in the art, as evidenced by Rothman. In particular, Rothman discloses the method according to claim 5, further comprising receiving by the issuer an existing term life insurance policy on the insured from the insured (Rothman: pg. 1 of 2).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the combined teachings of Pitti and Golden with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Golden, and further in view of Smith.

(A) As per claim 9, Pitti fails to expressly disclose the method according to claim 5, further comprising receiving by the issuer periodic payments from the insured.

Nevertheless, this feature is old and well known in the art, as evidenced by Smith. In particular, Smith discloses the method according to claim 5, further comprising receiving by the issuer periodic payments from the insured (Smith: pg. 1, par. [0010]).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Smith with the combined teachings of Pitti and Golden with the motivation of 1) providing a means of transferring assets (e.g.,

premiums) from a taxable classification, or status, to vehicles which can hold those assets in a non-taxable status and 2) reinvesting those assets into various investments (Smith: pg. 1, par. [0009] and [0010]).

12. Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Sobczak, further in view of Rothman, further in view of Golden, and further in view of Smith.

(A) As per claim 16, Pitti fails to expressly disclose the method according to claim 15, further comprising receiving by the issuer periodic premium payments from the insured.

Nevertheless, his feature is old and well known in the art, as evidenced by Smith. In particular, Smith discloses the method according to claim 15, further comprising receiving by the issuer periodic premium payments from the insured (Smith: pg. 1, par. [0010]).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Smith with the combined teachings of Pitti, Sobczak, Rothman, and Golden with the motivation of 1) providing a means of transferring assets (e.g., premiums) from a taxable classification, or status, to vehicles which can hold those assets in a non-taxable status and 2) reinvesting those assets into various investments (Smith: pg. 1, par. [0009] and [0010]).

(B) As per claim 23, Pittis fails to expressly disclose the method according to claim 22, further comprising receiving by the issuer periodic electronic payments from the insured representing a premium payment.

Nevertheless, this feature is old and well known in the art, as evidenced by Smith. In particular, Smith discloses the method according to claim 22, further comprising receiving by the issuer periodic electronic payments from the insured representing a premium payment (Smith: pg. 1, par. [0010]).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Smith with the combined teachings of Pitti, Sobczak, Rothman, and Golden with the motivation of 1) providing a means of transferring assets (e.g., premiums) from a taxable classification, or status, to vehicles which can hold those assets in a non-taxable status and 2) reinvesting those assets into various investments (Smith: pg. 1, par. [0009] and [0010]).

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Sobczak, and further in view of Golden.

(A) As per claim 19, Pitti discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(a) issuing a new combination investment/life insurance policy including an

investment vehicle comprised of said one or more new assets, rights or liabilities (Pitti: pgs. 52-54) (Examiner also notes Admission #1).

Pitti, however, fails to expressly disclose a method for modifying a combination investment/life insurance policy on an insured comprising:

(b) receiving ownership of the combination investment/life insurance policy; and

(c) receiving ownership of one or more new assets, rights or liabilities.

Nevertheless, these features are old and well known in the art, as evidenced by Sobczak and Golden. In particular, Sobczak discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(b) receiving ownership of the combination investment/life insurance policy (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/new owner/assignee (e.g., an issuer of insurance)).

Golden, on the other hand, discloses a method for modifying a combination investment/life insurance policy on an insured comprising:

(c) receiving ownership of one or more new assets, rights or liabilities (Golden: col. 12, lines 47-51).

One of ordinary skill would have found it obvious at the time of the invention to combine the aforementioned teachings of Sobczak with the teachings of Pitti with the motivation of providing consumers with additional insurance policy options and a tax saving mechanism (Sobczak: pgs. 1-2).

One of ordinary skill would also have found it obvious at the time of the invention to combine the aforementioned teachings of Golden with the combined teachings of Pitti and Sobczak with the motivation of providing a computerized insurance method and system for implementing and administering a program to provide a person with insurance that optimizes the use of their assets (Golden: col. 2, lines 24-45).

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitti in view of Sobczak, and further in view of Golden.

(A) As per claim 21, Sobczak discloses a method for replacing a term life insurance component in an existing combination investment/life insurance policy on an insured comprising:

(a) receiving ownership of a new term life insurance policy on the insured (Sobczak: pgs. 1-2) (Examiner notes that under Sobczak an insurance policy can be transferred to a trustee/beneficiary/owner/assignee (e.g., an issuer of insurance)).

Sobczak, however, fails to expressly disclose a method for replacing a term life insurance component in an existing combination investment/life insurance policy on an insured comprising:

(b) terminating an existing term life insurance policy on the insured, which existing term life insurance policy is owned by an issuer of the combination investment/life insurance policy.

Nevertheless, this feature is old and well known in the art, as evidenced by Rothman. In particular, Rothman discloses a method for replacing a term life insurance component in an existing combination investment/life insurance policy on an insured comprising:

(b) terminating an existing term life insurance policy on the insured, which existing term life insurance policy is owned by an issuer of the combination investment/life insurance policy (Rothman: pgs. 1-2).

One of ordinary skill would have found it obvious at the time of the invention to include the aforementioned teachings of Rothman with the teachings of Sobczak with the motivation of providing consumers with additional insurance policy options such as modification, termination, or replacement (Rothman: pgs. 1-2).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a computer-aided method, machine, and products produced thereby, for illustrating a replacement of a benefit plan that is viable at one location but not viable at the location of the replacement (6,411,939); a pension benefits system (4,750,121); a system for managing risks by combining risk insurance policy investments with risk prevention computer-based technology investments using common measurement methods (US 2002/0120558); a self-implementing pension benefits system (4,969,094); a system and method for predicting, comparing and presenting the cost of self insurance versus insurance and for creating bond financing when advantageous (6,009,402); an apparatus and method of composing a plan of flexible benefits (6.092,047); and an apparatus and method for processing and/or for providing healthcare information and/or healthcare-related information (6,283,761).

The cited but not applied prior art also includes non-patent literature articles by George Jackson and Kent Poff ("Cash Value Life Insurance vs. Term Insurance/Investment Combinations" Aug 1993. The Tax Advisor. pg. 521.) and Ben G. Baldwin Jr. ("Risk & Return Potential In Life Insurance Products" Apr 1998. Trusts & Estates. pg. 42.).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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MT 9.28.05

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